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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/712,838	11/13/2003	Preston A. Tanner	A310170.1US	9505

7590 02/24/2005

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EXAMINER

DURAND, PAUL R

ART UNIT	PAPER NUMBER
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3721

DATE MAILED: 02/24/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/712,838

Applicant(s)

TANNER, PRESTON A.

Examiner

Paul Durand

Art Unit

3721

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11/30/04.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2-13 and 21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 2-13 and 21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 2 and 9 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In regard to claim 2, as the claim is worded, the examiner cannot ascertain the metes and bounds of the claim. It appears the claim is trying to place the striker pin in both body portions and then one or the other

In regard to claim 9, it is not clear to the examiner limitation is being claimed, the term "spacer" appears to lack antecedent basis in regard to claim 6, and also appears to fail to further limit the parent claim.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 21 and 2-4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Clifford et al (US 3,711,008) in view of Copeland (US 329,278).

In regard to claim 21, Clifford discloses the invention substantially as claimed including a body 2, containing first and second ends with a longitudinal axis (no number given, but generally along the center of the body), an aperture 52, which extends through the body, having a first portion (no number given), which includes a carpet tack portion in the form of guide track 28, orientated along the axis, a tack strip track assembly, generally indicated by housing 3, footplate (no number given, but generally by reference number 3), with a guide channel formed by spacer 5, including a planar surface 4 orientated parallel to the reference axis and a striker pin in the form of drive head 38, which is hit by the hammer 44 located inside the body portion (see Figs. 1,2 and C2,L35 – C4,L17). What Clifford does not disclose is the use of an integral driving pin with a striking head located outside the body portion. However, Copeland teaches that it is old and well known in the art of member driving to have an integrated striking pin, comprised of shaft "a", located in the longitudinal body aperture and movable along the longitudinal axis, with a head "a8" which is located outside of a body portion for striking for the purpose of efficiently driving a fastener (see Figs. 1-3). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have provided the tool of Clifford with the driving means as taught by Copeland for the purpose of efficiently driving a fastener.

In regard to claim 2 and as the examiner understands the claim, Clifford discloses the invention substantially as claimed including a striker pin 38, that is arranged in a portion of the body (see Fig. 2).

In regard to claim 3, Clifford discloses the invention substantially as claimed including a combined striker pin portion comprised of head 38, hammer 44 and main hammer body 42 (see Fig. 2).

In regard to claim 4, Clifford discloses the invention substantially as claimed except for an integrated striker pin that is uniform in cross section. However, Copeland teaches that it is old and well known in the art of member driving to have an integrated striking pin "a1" that has a uniform cross-sectional area, which is constant in diameter and circularity for the purpose of preventing misalignments during driving (see Fig. 2). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have provided the tool of Clifford with the driving means as taught by Copeland for the purpose of preventing misalignments during driving.

5. Claims 5 and 10-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Clifford et al and Copeland as applied to claim 1 and in further view of Henning (US 3,060,441).

In regard to claim 5, the modified invention of Clifford discloses the invention substantially as claimed as applied to claim 1 above except for a shock absorbing material on a portion of the body. However, Henning teaches that it is old and well known in the art of member driving to have a handle 35, located on the body 5 and comprised of shock absorbing material (rubber) for the purpose of reducing impact shock during use (see Fig.3 and C4,L12-14 and L64-72). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to

Art Unit: 3721

have provided the modified tool of Clifford with the handle means as taught by Henning for the purpose of reducing impact shock during use.

In regard to claims 10-13, the modified invention of Clifford discloses the invention substantially as claimed as applied to claim 1 above except for a handle located on a portion of the body. However, Henning teaches that it is old and well known in the art of member driving to have a handle 33, immovably located between a first and a second portion of the body and comprised of shock absorbing material (rubber) for the purpose of reducing impact shock during use (see Fig.3 and C4,L12-14 and L64-72). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have provided the modified tool of Clifford with the handle means as taught by Henning for the purpose of reducing impact shock during use.

6. Claims 6-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Clifford et al and Copeland as applied to claim 1 and in further view of Hilti (US 3,324,542 and in further view of applicant's admitted prior art.

In regard to claims 6,7 and 9, the modified invention of Clifford discloses the invention substantially as claimed as applied to claim 1 above except for the use or a rubber extension attached to a second end of the body. However, Hilti teaches that it is old and well known in the art of member driving to have a handle (no number given), attached to a second end of guide, with a washer indentation in the handle which prevents further movement and where the top of the handle and the bottom of spacer in the form of flange 28 limit the size of the tool for the purpose of reducing shock during

Art Unit: 3721

use (see Figs. 1-3 and C2,L44-68). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have provided the modified tool of Clifford with the handle means as taught by Hilti for the purpose of reducing impact shock during use.

Furthermore, in regard to the limitation of the material being made from rubber, because applicant did not challenge the Official Notice taken in the prior Office Action that it is old and well known in the art, and as evidenced by the rejection of claim 5 above, that it is old and well known in the art of driving tools to manufacture a handle from a rubberized compound for the purpose of improving grip and reducing vibration, this is now deemed an admission that such is admitted prior art. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have provided the modified tool of Clifford with the handle manufactured from rubber for the purpose of improving grip and reducing vibration.

In regard to claim 8, the modified invention of Clifford discloses the invention substantially as claimed as applied to claim 1 including a spring "a5", located between the impact head "a8" and a limiting section (no number given) which washer shaped and prevents further movement (see Fig. 2).

Response to Arguments

7. Applicant's arguments filed 11/30/04 have been fully considered but they are not persuasive.

Applicant argues that the amended matter introduced into new claim 21 places the claim in condition for allowance. The examiner disagrees with this argument, and

Art Unit: 3721

asserts that the claims as recited, especially the tack strip track assembly are still rejected under the prior art cited above.

Therefore, for the reason indicated above, the rejection is deemed proper.

Conclusion

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

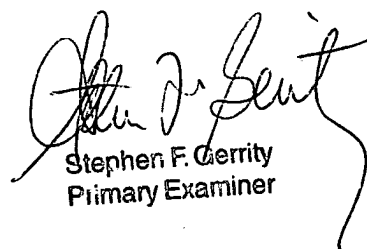
9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul Durand whose telephone number is 571-272-4459. The examiner can normally be reached on 0730-1800, Monday - Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rinaldi I Rada can be reached on 571-272-4467. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 3721

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Paul Durand
February 22, 2005



Stephen F. Gerrity
Primary Examiner